



UNITED STATES PATENT AND TRADEMARK OFFICE

cl
UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/535,683	05/19/2005	Jon Valgeirsson	2815-0308PUS1	9731
2292 7590 01/28/2008 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			EXAMINER CHUNG, SUSANNAH LEE	
			ART UNIT 1626	PAPER NUMBER
			NOTIFICATION DATE 01/28/2008	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary	Application No. 10/535,683	Applicant(s) VALGEIRSSON ET AL.	
	Examiner Susannah Chung	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) 7-17, 19, 20 and 28-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 27 is/are rejected.
- 7) ☒ Claim(s) 5, 6, 18 and 21-26 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>5/19/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-32 are pending in the instant application. Claim 33 is canceled by preliminary amendment.

Priority

This application is a 371 of PCT/DK03/00768, filed 11/10/2003.

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d) by application no. 2002 01803 filed in the Denmark Patent Office on 11/21/2002, which papers have been placed of record in the file. The application names an inventor or inventors named in the prior application.

Information Disclosure Statement

The information disclosure statement (IDS), filed on 05/09/2005 has been considered. Please refer to Applicant's copy of the 1449 submitted herewith.

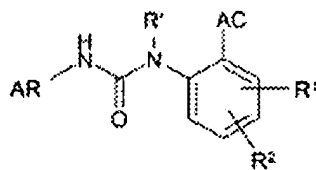
Response to Election/Restrictions

Applicant's election without traverse of Group I in the reply filed on 11/29/2007 is acknowledged. Specially, the election of species of 2-[3-(3-bromo-phenyl)-ureido]-4-chloro-5-methyl-benzenesulfonic acid for initial search and examination purposes is acknowledged.

Scope of the Elected Invention

Claims 1-32 are pending in this application.

The scope of the elected subject matter that will be examined and searched is as follows:



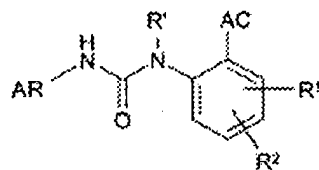
Compounds of formula (I), , depicted in claim 1, wherein:

Art Unit: 1626

AC is SO₂OH or SO₂NH₂.

Scope of Withdrawn Subject Matter

Claims 7-17, 19-20 and 28-32 are withdrawn from further consideration by the examiner, 37 C.F.R. §1.142(b), as being drawn to a non-elected invention. The withdrawn subject matter is patentably distinct from the elected subject matter as it differs in structure and element and would require separate search considerations. In addition, a reference, which anticipates one group, would not render obvious the other.



Compounds of formula (I), , depicted in claim 1, wherein:

AC is $-(CH_2)_nCOOH$ or $-(CX)OH$. The withdrawn subject matter may be pursued in a divisional or continuation application at a later time.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Webster, et al (U.S. Pat. No. 3,332,981).

Applicants claims of aryl ureido derivatives of formula (I) relate to the compounds of claims 1 and 4. Webster discloses compounds in claims 1 and 4 that anticipate the instantly claimed genus wherein: **AC** is SO₂OH, **R'** is hydrogen, **AR** is phenyl; R₁ and R₂ are hydrogen,

Art Unit: 1626

halogen or cycloalkyl, which reads on the instant claims. (See Webster et al., Claims 1 and 4, Column 4, CAS RN 17347-44-3, 6-chloro-4-(3-phenylureido)-3-stilbenesulfonic acid.)

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Nagai, et al (U.S. Pat. No. 5,665,675).

Applicants claims of aryl ureido derivatives of formula (I) relate to the compounds of claims 1-18. Nagai discloses compounds in claims 1-18 that anticipate the instantly claimed genus wherein: **AC** is SO₂NH₂, **R'** is hydrogen, **AR** is phenyl; **R1** and **R2** are hydrogen, halogen, alkyl, or cycloalkyl, which reads on the instant claims. (See Nagai et al., Claims 1-18, Columns 33-36, CAS RN 175014-56-9, 2-[[[(phenylamino)carbonyl]amino]-benzenesulfonamide. Also see Nagai et al., structures on Columns 4-8.)

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Minami, et al (U.S. Pat. No. 5,710,094).

Art Unit: 1626

Applicants claims of aryl ureido derivatives of formula (I) relate to the compounds of claims 1-17. Minami discloses compounds in claims 1-18 that anticipate the instantly claimed genus wherein: **AC** is SO₂NH₂, **R'** is hydrogen, **AR** is phenyl; **R1** and **R2** are hydrogen, halogen, alkyl, or cycloalkyl, which reads on the instant claims. (See Minami et al., Claims 1-17, Columns 67-71, CAS RN 175014-56-9, 2-[[[(phenylamino)carbonyl]amino]-benzenesulfonamide. Also see Nagai et al., structures on Columns 5-10.)

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Nagai, et al (U.S. Pat. No. 5,811,369).

Applicants claims of aryl ureido derivatives of formula (I) relate to the compounds of claims 1-17 and 26. Nagai discloses compounds in claims 1-17 and 26 that anticipate the instantly claimed genus wherein: **AC** is SO₂NH₂, **R'** is hydrogen, **AR** is phenyl; **R1** and **R2** are hydrogen, halogen, alkyl, or cycloalkyl, which reads on the instant claims. (See Nagai et al., Claims 1-17 and 26, Columns 23-28, CAS RN 175014-56-9, 2-[[[(phenylamino)carbonyl]amino]-benzenesulfonamide. Also see Nagai et al., structures on Columns 4-10.)

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 1626

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Fukuchi, et al (U.S. Pat. No. 5,811,368).

Applicants claims of aryl ureido derivatives of formula (I) relate to the compounds of claims 1-20. Fukuchi discloses compounds in claims 1-20 that anticipate the instantly claimed genus wherein: **AC** is SO₂NH₂, **R'** is hydrogen, **AR** is phenyl; **R1** and **R2** are hydrogen, halogen, alkyl, or cycloalkyl, which reads on the instant claims. (See Fukuchi et al., Claims 1-20, CAS RN 175014-56-9, 2-[[[(phenylamino)carbonyl]amino]-benzenesulfonamide. Also see Fukuchi et al., structures on Columns 3-8.)

Claim Rejections - 35 USC § 112, 1st paragraph

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 27 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The term “therapeutically effective amount” of the compounds of Claim 1 is not defined in the specification so as to know the amount that is included and/or excluded by the term. Therefore, the specification lacks adequate support for Claim 27.

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susannah Chung whose telephone number is (571) 272-6098. The examiner can normally be reached on M-F, 8am-5pm.

Art Unit: 1626

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on (571) 272-0699. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SLC

REBECCA ANDERSON
PRIMARY EXAMINER

Rebecca Anderson
Primary Patent Examiner
Art Unit 1626, Group 1620
Technology Center 1600

Date: 21 January 2008